

## REMARKS

This Amendment is submitted under 37 C.F.R. § 1.111 in response to the Office Action dated January 8, 2004, wherein all of the pending claims, *i.e.*, claims 1 – 9, were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,595,671 to Rockwell, III. Claims 10 – 46 were previously withdrawn in response to a Restriction Requirement. In this Amendment applicants traverse the rejection of claims 1 – 9 for the reasons discussed below, cancel withdrawn claims 10 – 46 without prejudice, and add new independent claim 47 covering an embodiment which is similar to the embodiment of claim 1. Claims 1 – 9 and 47 are pending. Reexamination and reconsideration of the application are respectfully requested.

### New Claim 47

New claim 47 has been added. Claim 47 is very similar to claim 1, except that it recites the step of forming a plurality of recesses in the first cladding layer rather than a single recess, as in claim 1. Thus, in claim 47 it is not necessary to form multiple electrode assemblies in a single recess. Instead, each electrode assembly may be formed in a corresponding recess in the first cladding layer. Applicant submits that this is a minor variation of the structure recited in claim 1, and is not disclosed or suggested by any of the prior art of record.

### Traversal of Rejection

All of the pending claims of the present application were rejected on the sole ground that they are anticipated by the Rockwell III patent. Independent claim 1 requires the steps of “forming a first recess in the first cladding layer” and “disposing a plurality of first deflector electrode assemblies in said first recess.” Independent claim 47 is similar, but specifies the use of a plurality of recesses. One of the most fundamental principles of patent law is that there can be no anticipation if the reference relied upon does not teach *everything* specified in the claim at issue. Here, the Rockwell III reference relied upon by the examiner as anticipating claim 1 does not teach the step of forming one (or more than one) recess in the *cladding* layer, *nor* does it teach the step of forming *electrode assemblies* in recesses. Therefore, Rockwell III does not anticipate any of the pending claims of the instant application.

The word “recess” does not appear anywhere in Rockwell. Nowhere does the patent describe or suggest placing electrodes or electrode assemblies in a recess-like structure.

The examiner refers to column 21, lines 11 – 29, of Rockwell III to support the rejection. However, this discussion is directed to forming opaque light blocking structures in a light diffusion layer for enhancing the performance of the display screen. The light blocking structures are *not* electrode assemblies, as required by the claims of the present application, and the light diffusion layer is *not* a cladding layer, as required by the claims of the present application. Thus, the discussion in Rockwell III cited by the examiner does not teach forming electrode assemblies in recesses in a first cladding layer and, therefore, does not anticipate the claims of the present application. Nor is there any other discussion in Rockwell III which teaches these claim requirements.

In traversing the rejection, Applicants' focus on Rockwell III's failure to teach forming electrode assemblies in one or more recesses in a first cladding layer should not be construed as an admission that the other elements of the rejected claims are taught by the reference. In rebutting the examiner's anticipation rejection applicants believe it is sufficient to show that these two elements of all the pending claims are clearly missing from the Rockwell III reference, and that it is unnecessary to show more.

Although the examiner did not reject any of the claims of the application under 35 U.S.C. § 103 as being "obvious", applicants wish to comment on why Rockwell III does not make the claims of the current application obvious. Rockwell III is directed to a much different type of apparatus than the present invention – a display screen – wherein light is "tapped" from individual waveguides at intermediate locations to form light pixels on the screen. Light is transmitted through a plurality of individual waveguides, and tapped out as needed. The individual waveguides may be very long. In contrast, the present invention is directed to an optical switch which is used to change the direction of light beams traveling *within* a slab waveguide, so that it is directed from a selected input to a selected output port. According to the present invention, light is not tapped out of the waveguide at an intermediate position.

Rockwell III has a predominant concern with low-cost, efficient manufacturing techniques. Forming recesses in a cladding layer is inconsistent with this predominant concern with low cost manufacturing. Thus, there is no reason or motivation why someone skilled in the art would modify the teachings of Rockwell III to add the expensive, time-consuming steps of forming one or more recesses in a cladding layer, and then form electrode assemblies in these recesses. There is nothing within the reference which teaches or suggests any benefit from such

a construction technique. In addition, the preferred mechanism in Rockwell III for tapping light out of waveguides is by acoustic means, and there is nothing which suggests that greater efficiency, or any other benefit, would be attained by placing electrode assemblies in recesses in the cladding layer. Accordingly, it is submitted that the claims of the present invention are not obvious in view of Rockwell III.

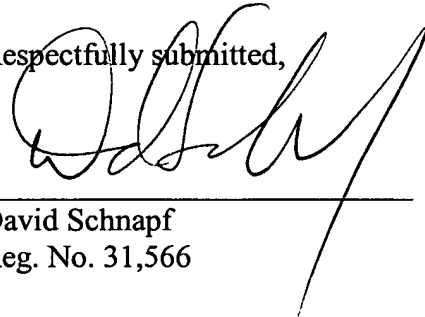
As noted, none of the claims have been rejected as being "obvious" over Rockwell III, and so these comments are offered for purpose of advancing the prosecution of this matter. Applicants' reserve the right to offer more complete comments on this issue in the event a *new* rejection is made under § 103. It is noted that a new rejection under § 103 cannot be made "final" in view of the fact that no claim amendments have been made.

### **Conclusion**

In view of the foregoing amendments and remarks, Applicants submit that the case is now in condition for allowance and such action is earnestly solicited. The examiner is invited to telephone the undersigned at the below-listed number if doing so would advance the prosecution of the application.

April 6, 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David Schnapf', is written over a horizontal line. The signature is stylized and cursive.

David Schnapf  
Reg. No. 31,566

Sheppard Mullin Richter & Hampton LLP  
Four Embarcadero Center, 17<sup>th</sup> Floor  
San Francisco, CA 94111-4106  
Tel: (415) 434-9100  
Fax: (415) 434-3947